



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of )  
Andreas Obrebski et al. ) Group Art Unit: 2872  
Application No.: 10/730,021 ) Examiner: Thong Q. Nguyen  
Filed: December 9, 2003 )  
For: SURGICAL MICROSCOPY )  
SYSTEM )

**LETTER RE OBJECTIONS TO INFORMATION DISCLOSURE STATEMENT (IDS)**

Commissioner for Patents  
Alexandria, VA 22313-1450

Sir:

In response to the IDS objections raised in the Official Action dated April 4, 2006 and the phone conversation of April 25, 2006 with the Examiner regarding these objections, Applicants kindly request the Examiner to consider and make of record all of the documents submitted with the IDSs filed on May 10, 2004 and July 8, 2004. Please note that this paper is not intended as a complete response to the Official Action and that the other issues raised therein will be addressed by Applicants in a subsequent filing.

Initially, Applicants note with appreciation that the Examiner has considered and made of record most of the documents submitted with the Information Disclosure Statements filed on May 10, 2004 and July 8, 2004. The two exceptions are described below.

First, foreign patent document DE 43 34 069 A1 was not considered. The

reason provided in the Official Action was that "the reference to the U.S. Patent No. 5,667,186 as provided for the mentioned foreign reference is incorrect". The relevant rule is 37 CFR 1.98(a)(3) which requires that Applicants provide:

"A concise explanation of the relevance, as it is presently understood by the individual designated in § 1.56(c) most knowledgeable about the content of the information, of each patent, publication, or other information listed that is not in the English language. The concise explanation may be either separate from applicant's specification or incorporated therein."

In this case, Applicants satisfied this requirement by listing the foreign patent document DE 43 34 069 A1, as its explanation of relevance, U.S. Patent No. 5,667,186 which claims priority therefrom. As discussed with the Examiner telephonically, the Examiner intends to verify the above statement. To assist in the Examiner in reviewing the above statement, herewith a copy of U.S. Patent Number 5,667,186 which claims priority from DE 43 34 069 A1 is enclosed.


Second, a translated copy of Combitrans - Kontaktlose Drehübertrager Fur Energie Und Daten, Catalog for MST Aerospace GmbH pages 3-5 was not considered. The reason provided in the Official Action was that "The reference titled thereof 'Combitrans-Kontaktlose....Aerospace' and its translation as provided in the information disclosure statement filed 7/8/2004 fails comply with 37 CFR 1.98(a)(2) which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed." In this case, Applicants satisfied this requirement by submitting the document with the IDS filed on July 8, 2004. As discussed with the Examiner telephonically, another translated copy of the relevant pages (3-5) of "Combitrans - Kontaktlose Drehübertrager Fur Energie Und

Daten, Catalog for MST Aerospace GmbH" is being resubmitted for the Examiner's review.

All IDS objections raised in the Official Action have been addressed, and the Examiner is respectfully requested to consider the two aforementioned previously submitted items and to initial and return copies of the corresponding form PTO-1449s (enclosed). Should the Examiner have any questions regarding this letter the application in general, she or he is invited to contact the undersigned at (540) 361-1863. Our complete response to the other issues raised in the Official Action will follow.

Respectfully submitted,

POTOMAC PATENT GROUP PLLC

By:   
Steven M. duBois  
Registration No. 35,023

Date: April 28, 2006

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| <b>INFORMATION DISCLOSURE<br/>STATEMENT BY APPLICANT</b><br>(Use as many sheets as necessary) |                 |                              |  | <b>Complete if Known</b> |                         |
|   |                 |                              |  | Application Number       | 10/730,021              |
|   |                 |                              |  | Filing Date              | December 9, 2003        |
|   |                 |                              |  | First Named Inventor     | Andreas OBREBSKI et al. |
|   |                 |                              |  | Art Unit                 | 2872                    |
| Examiner Name   | Thong Q. Nguyen |                              |  |                          |                         |
| Sheet 1   | of 2            | Attorney Docket No. 0902-009 |  |                          |                         |

## U.S. PATENT DOCUMENTS

| Examiner Initials* | Cite No <sup>1</sup> | Document Number<br>Number-Kind Code <sup>2</sup> (if known) | Publication Date<br>MM-DD-YYYY | Name of Patentee or Applicant of Cited Document | Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear |
|--------------------|----------------------|---|--------------------------------|---|---|
|                    |                      | U.S. 5,667,186  | 09/16/1997                     | Luber et al.                                    |   |
|                    |                      | U.S.  |                                |   |   |
|                    |                      | U.S.  |                                |   |   |
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## FOREIGN PATENT DOCUMENTS

| Examiner's Initials* | Cite No <sup>1</sup> | Foreign Patent Document<br>"Country Code" <sup>3</sup> "Number" <sup>4</sup><br>"Kind Code" <sup>5</sup> (If known) | Publication Date<br>MM-DD-YYYY | Name of Patentee or Applicant of Cited Document | Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear | T <sup>6</sup> |
|----------------------|----------------------|---|--------------------------------|---|---|----------------|
|                      |                      | DE 43 34 069 A1   | 04/13/1995                     | Carl Zeiss                                      |   |                |
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| Examiner's Signature | Date Considered |
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EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant. <sup>1</sup> Applicant's unique citation designation number (optional). <sup>2</sup> See Kinds Codes of USPTO Patent Documents at [www.uspto.gov](http://www.uspto.gov) or MPEP 901.04. <sup>3</sup> Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). <sup>4</sup> For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. <sup>5</sup> Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST.16 if possible. <sup>6</sup> Applicant is to place a check mark here if English language Translation is attached.

This collection of information is required by 37 CFR 1.97 and 1.98. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450. If you need assistance in completing the form, call 1-800-PTO-9199 (1-800-786-9199) and select option \*

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|   |   |    |   | Art Unit                 | 2872                    |
|   |   |    |   | Examiner Name            | Thong Q. Nguyen         |
| Sheet   | 2 | of | 2 | Attorney Docket No.      | 0902-009                |

### NON-PATENT LITERATURE DOCUMENTS

| Examiner's<br>Initials* | Cite No <sup>1</sup> | Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published. | T <sup>2</sup> |
|-------------------------|----------------------|---|----------------|
|                         |                      | COMBITRANS - Kontaktlose Drehübertrager für Energie Und Daten, Catalog for MST Aerospace GmbH, pp. 1-24 [with translation of relevant sections on pages 3-5]  |                |
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